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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,711	12/30/1999	DAVID O. MCGOVERAN		8198

7590 10/16/2002

GEORGE S COLE  
495 SEAPORT COURT SUITE 101  
REDWOOD CITY, CA 94063

EXAMINER

BOYCE, ANDRE D

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 10/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/476,711

Applicant(s)

MCGOVERAN, DAVID O.

Examiner

Andre Boyce

Art Unit

3623

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 26 July 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. This Final Office Action is in response to Applicant's amendment filed July 26, 2002. Claims 1-12 have been amended and claims 13-15 have been added. Claims 1-15 are pending.
2. The previously pending objection to the drawings have been withdrawn.  
The previously pending objections to the specification due to the missing brief description of the drawings and various typographical errors are withdrawn.  
The previously pending objection to claim 7 and objection to all the claims for single spacing have been withdrawn.  
The previously pending rejections to claims 2, 5-6, and 9-11 under 35 USC § 112 are withdrawn, however the rejections to claims 4, 8, and 12 are maintained, as seen below.
3. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection, necessitated by Applicant's amendment.

***New Matter Added to the Specification***

4. The amendment filed July 26, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. With reference to the newly submitted specification filed July 26, 2002, the added material which is not supported by the original disclosure is as follows: page 4, lines 3-8 and 22-26, page 6, lines 1-28, page 7, lines 1-25, page 13, lines 19-22, page 17, lines 15-21, page 18, lines 16-28, page 19, lines 1-28, page 20 lines 1-14, page 29, line 28, page 30, lines 1-5, page 31, lines 22-28, and page 32, lines 1-10. The above page and line numbers are denoted by angled brackets, as seen in the marked up version of the specification filed July 26, 2002.

Claims 1-8 and 13-15 also contain new matter not originally disclosed and are rejected to as seen below. Further, the specification submitted July 26, 2002 has not been entered, due to the new matter added.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8 and 13-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way

as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "...through an emergent and inductive approach that anticipates possible conditions and desired actions...", which was added via the Applicant's amendment filed July 26, 2002 and was not described in the original specification, and is considered to be new matter. Claims 2-8 depend either directly or indirectly from claim 1, thereby containing the same new matter therein.

Claim 13, which was added via the Applicant's amendment filed July 26, 2002, recites "A method for inducing a business process from a set of defined conditions..." This portion of the claim was not described in the original specification and is considered to be new matter.

Claims 14-15 were added via Applicant's amendment filed July 26, 2002. The limitations therein were not described in the original specification and are considered to be new matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4, 8, and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 8 are rendered vague and indefinite, since they contain both an apparatus (i.e. general purpose computer) and the method steps incorporated therein.

Claim 12 recites the limitation "said particular action" and "said dynamic process". There is insufficient antecedent basis for this limitation in the claim.

Claim 13 is rendered vague and indefinite, since it is a hybrid claim incorporating a means into the method. See MPEP 2173.05(p). In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bidgoli, Handbook of Management Information Systems: A Managerial Perspective, November 1998.

As per claim 1, Bidgoli discloses a method for **dynamically** managing a process **through an emergent and inductive approach that anticipates possible conditions and desired actions** (total quality management (TQM), see page 276-277), comprising declaring an objective of the process as a set of measurable goals and constraints (quality measurement, page 280), stating **for each objective at**

**least one corresponding and applicable** set of rules wherein each rule contains both a condition governing that rule's actuation, and that rule's action when the condition is met, and wherein the set of rules may act in any combination, subject to the limitation that the condition of a particular rule must be met before the particular action may occur, testing each rule against conditions both internal and external, as they exist in the real world, without specifying the order of testing, unless the order becomes governed by the actuation of at least one rule whose precondition governing its actuation becomes satisfied (continuous improvement, page 281), actuating a rule when its condition is met (inference engine, see page 501), and delegating the objective as declared in a set of measurable goals and constraints, the corresponding and applicable set of rules, and responsibility for attaining the objective and for testing, actuating, and further delegating the objective and rules to at least one specific actor, wherein each said specific actor inherits from all superior actors conditions as constraints and actions as goals, and passes upwards all actions as instantiations of conditions, and all information necessary for altering any objective when the objective does not conform to the real world (quality measurement, page 280).

As per claims 2 and 6, Bidgoli discloses the steps done in a declarative method suitable for reduction to a form of formal logic (repeatable and measurable, quality measurement, page 280).

Claims 3-4 are rejected based upon the rejection of claim 1, since they are the method steps instantiated in a computer program and the general-purpose computer programmed to implement the method, respectively, corresponding to claim 1.

As per claim 5, Bidgoli discloses internalizing feedback for both performance and process by incorporating into the method steps for creating, differentiating, modifying, and deleting any objective, goal, constraint, set of rules or rule (continuous feedback, page 281).

Claims 7-8 are rejected based upon the rejection of claim 5, since they are the method steps instantiated in a computer program and the general-purpose computer programmed to implement the method, respectively, corresponding to claim 1.

Claim 9 is rejected based upon the rejections of claims 1 and 5, since it contains the same limitations therein.

As per claim 10, Bidgoli discloses using the occurrence of a logical contradiction created or encountered by the method to improve the method by identifying the two or more objectives, goals, constraints, sets of rules, or rules that produce the logical contradiction, and using the steps for creating, differentiating, modifying, and deleting any objective, goal, constraint, set of rules or rule to produce a distinct new method lacking any logical contradiction (rule based expert system, page 506, 1<sup>st</sup> paragraph).

As per claim 11, Bidgoli discloses avoiding altering the delegation above the level in which the logical contradiction occurred (universal responsibility, page 284).



Claim 12 is rejected based upon the rejection of claim 9, since it is the device claim corresponding to the method claim.

Claim 13 is rejected based upon the rejection of claim 9, since it contains the same limitations therein. Further, Bidgoli discloses the method used in a business process (page 294).

As per claim 14, Bidgoli discloses creating and maintaining a dynamic and self-referential representation of the induced business process within the model, and changing the dynamic and the self-referential representation as and in accordance with each change in the set of defined conditions, constraints, rules, and elements comprising the model (continuous improvement, page 289-290).

As per claim 15, Bidgoli discloses including at least one anticipatory defined condition, constraint, rule, or element (continuous improvement, page 289-290).

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (703) 305-1867. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and After Final communications, and (703) 746-7305 for draft/informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



adb  
October 10, 2002



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